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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,948	04/02/2004	Dieter Schwarz	46325	8917

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EXAMINER

HARVEY, JAMES R

ART UNIT PAPER NUMBER

2833

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/815,948

Applicant(s)

SCHWARZ, DIETER

Examiner

James R. Harvey

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 13-20 is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8 and 10-12 is/are rejected.
- 7) ☒ Claim(s) 5, 6 and 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4-2-04 & 7-13-04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Information Disclosure Statement

- The Information Disclosure statement(s) and related documents that were filed on 4-2-04 and 7-13-04 have been considered.

Priority

- Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Abstract

The abstract is objected to because it appears that “of” should be deleted and —to—should be inserted to correct a typographical error on line 1 of the abstract.

Specification

- It appears that there is a typographical error on page 6 of applicant's specification; “10/444941” should end in with the numeral 9 instead of ending with the numeral 1.

Claim Objections

- Claim(s) 7 is/are objected to because of the following informalities:
 - In reference to Claim(s) 7, the recitation “interacting means” is not defined in the specification or the drawings so that the public is made aware of the meets and bounds of the recitation. For purposes of examination, it is assumed that the language is intended to mean any action reaction within the housing. An examination based on the merits, as best understood, is addressed below.
 - Appropriate response to the above is required.

Claim Rejections - 35 USC § 102

- The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

- The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

** Claim(s) 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (4165141).

-- In reference to Claim(s) 1, Williams shows (cover sheet)

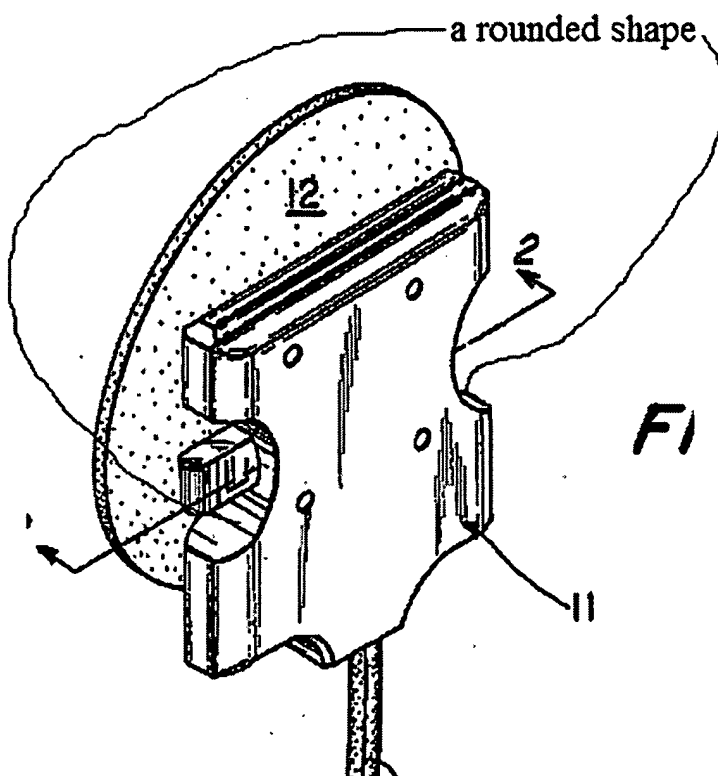
a housing 11;

a first contact member 21 mounted in the housing for connection to a contact pin 13 of an electrode 12, the contact member 21 having first energy storage element 18 for spring biasing the contact member 21 to engage the contact pin 13; and a first actuating element 15 mounted in the housing 11 to deflect the energy storing element 18 and move the contact member 21 to an open position to receive the contact pin 13.

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-- In reference to Claim(s) 2, Williams shows (cover sheet) the electrode is a medical skin electrode.

-- In reference to Claim(s) 10, Williams shows (figure 1) the housing a top with a rounded shape (see examiner's figure).



** Claim(s) 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. in view of Strand (5454739) and further in view of Foreign Patent EP 0 325 573 A2.

-- In reference to Claim(s) 11 and 12, Williams shows (cover sheet) the housing has a surface facing the electrode to be engaged. Williams teaches (column 2, line 39) that the housing can be made out of any suitable material.

However, Williams does not show the surface having an elastoplastic wall having a hardness less than hardnesses of other walls of the housing of claim 11 or that the elastoplastic wall is made from a thermoplastic elastomer.

It is known that an elastomer softens when heated yet maintains its elastic behavior upon cooling and they are widely used in making machine parts, house-ware, adhesives and toys (see attached definition from the Academic Press Dictionary of Science and Technology).

Strand teaches that it is known to use deformable layers with biomedical electrodes (column 5, lines 20-32).

EP 032573 teaches (cover sheet) that it is known to use elastoplastic blends of particles dispersed in thermoplastic polymers.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a material for use with the invention of Williams with a material similar to the mating material as taught by Strand and to have it be an elastoplastic made from a thermoplastic elastomer, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416 (CCPA 1960). One skilled in the art would have been motivated to make the substitution in order to meet the particular preferences of the customer or meet the particular best practice standards of the biomedical industry or because such an elastomer soften when heated for processing.

** Claim(s) 1,2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated Faupel et al. (5895298).

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-- In reference to Claim(s) 1, Faupel shows (cover sheet)

a housing 12; a first contact member 62 mounted in the housing for connection to a contact pin of an electrode 35, the contact member 62 having first energy storage element 56 for spring biasing the contact member 62 to engage the contact pin; and a first actuating element 48 mounted in the housing to deflect the energy storing element and move the contact member to an open position to receive the contact pin.

-- In reference to Claim(s) 2, Faupel shows (cover sheet) the electrode 35 is a medical skin electrode.

-- In reference to Claim(s) 8, Faupel shows (cover sheet)

a second contact member 64 is mounted in the housing for connection to the contact pin and has a second energy storing element 54 for spring biasing the second contact member to engage the contact pin; and a second actuating element 50 is mounted in the housing to deflect the second energy storing element and move the second contact member to an open position to receive the contact pin.

** Claim(s) 1,3,4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Machcinski (4468073).

-- In reference to Claim(s) 1, Machcinski shows (figures 1, 4 and 5)

a housing 10;

a first contact member 16 mounted in the housing,

the contact member 16 having first energy storage element 24 for spring biasing the contact member; and a first actuating element 38 mounted in the housing to deflect the energy storing element and move the contact member to an open position.

In particular reference to the recitations “for connection to a contact pin of an electrode, to engage the contact pin and to receive the contact pin” they are seen to be for the intended use of the claimed structure and is given little patentable weight, since it has been held a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Further, the claim language is not seen to claim any structure that would inhibit the reference from being used for the same purpose as the intended use recitations of the claim.

-- In reference to Claim(s) 3, Machcinski shows (figures 4 and 5) the actuating element 38 is connected eccentrically on a rotatably mounted drive element 48. Machcinski is seen to be mounted eccentrically because the drive element 48 is seen to be mounted at various tangent points that follow an elliptical path as the rectangular cross-section of the drive element moves from the horizontal to vertical positions in figures 4 and 5.

-- In reference to Claim(s) 4, Machcinski shows (figures 4 and 5) the drive element 48 has an eccentrically extending contact surface (the tangential points of contact between the drive element 48 and the actuating element 38), such that when the drive element 48 is rotated the contact member is moved to the open position.

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-- In reference to Claim(s) 7, Machcinski shows (figures 4 and 5) the drive element 48 and the actuating element 38 have interacting means (the complimentary horizontal and vertical surfaces shown in figure 4) for limiting displacement of the actuating element.

Allowable Subject Matter

- Claim(s) following claims has(have) allowable subject matter.
- Claim(s) 5,6 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- The following is a statement of reasons for the indication of allowable subject matter: The prior art does not show the structure of the drive element and the actuating element are eccentrically connected to one another by a pin and slot arrangement (claims 5 and 6) and the first and second actuating elements are eccentrically connected on a common rotatably mounted drive element (claim 9). This structure, in combination with all the other elements of the claim is not seen to be anticipated by the prior art and the examiner knows of no permissible motivation to combine the prior art such that the subject matter as a whole would have been obvious at the time the invention was made.

If the application becomes allowable, any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowable Subject Matter".

Reasons for Allowance

- Claim(s) 13-20 are allowed.
- The following is an examiner's statement of reasons for allowance: The prior art does not show the housing having a bore, a driving element rotatable mounted in the bore and having a cam, a contact member engaged by the cam and a first actuating element eccentrically coupled to the driving element (claim 13) in combination with all the other elements of the claim and the examiner knows of no permissible motivation to combine the prior art such that the subject matter as a whole would have been obvious at the time the invention was made.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

- The prior art listed on PTO form 892 that is made of record and not relied upon is considered pertinent to applicant's disclosure because it shows the state of the art with respect to applicant's claimed invention.
- Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Harvey whose telephone number is 571-272-2007. The examiner can normally be reached on 8:00 A.M. To 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on 571-272-2800 extension 33.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2800.

- Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

James R. Harvey, Examiner

jrh

June 3, 2005

A handwritten signature in black ink, appearing to read 'JRH', with a long horizontal line extending to the right.